

REMARKS

The Office action dated November 15, 2004 is acknowledged. Claims 1 – 11 are pending in the instant application. According to the Office action, each of these claims has been rejected. By the present Office action response, claims 1, 2, 4, 9 and 11 have been amended and claims 3 and 8 have been canceled. Support for the amendments to the claims can be found at page 3, lines 18-22, page 3, line 31 to page 4, line 2 and in the drawings. No new matter has been added. Reconsideration is respectfully requested in light of the amendments being made herein and of the following remarks.

Rejection of Claim 3 under 35 U.S.C. 112, second paragraph

Claim 3 has been rejected under 35 U.S.C., second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that there is no antecedent basis for “the seat back frame” and “the backrest frame.” The applicants submit that claim 3 has been canceled and that the pertinent subject matter of claim 3 has been incorporated into claim 1. Therefore, this rejection is no longer germane and withdrawal thereof is respectfully requested.

Rejection of Claims 1, 4-7, 10 and 11 under 35 U.S.C. 102(e)

Claims 1, 4-7, 10 and 11 has been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,540,296 (Shats, et al.). According to the Examiner, this reference teaches each and every feature of the present invention set forth in claims 1, 4-7, 10 and 11, namely, a seat, a seat back and a backrest displaceably arranged relative to the seat by means of a locking mechanism having a concealed operating mechanism.

Applicant refers to MPEP 706.02(b), which provides that a rejection based on 35 U.S.C. 102(e) can be overcome by:

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art;
- (B) Amending the claims to be patentably distinguishable over the prior art;
- (C) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by “another;”
- (D) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 1.601(n);
- (E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) within the time period set in 37 CFR 1.55(a)(1) or filing a grantable petition under 37 CFR 1.55(c); or
- (F) Perfecting priority under 35 U.S.C. 119(e) or 120, within the time periods set in 37 CFR 1.78(a) or filing a grantable petition under 37 CFR 1.78(a), by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet which contains a specific reference to a prior application in accordance with 37 CFR 1.78(a), and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph.

Moreover, the prior art must disclose each and every element as set forth in the claims, either expressly or inherently. *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The applicants respectfully submit that the present invention is patentably distinct from the invention disclosed in this reference. Specifically, each and every feature of the present invention as recited in present claims 1, 4-7, 10 and 11 is not taught or disclosed in Shats, et al. Claim 1 of the present application claims a seating arrangement having “a seat back extending upwardly from the seat base, the seat back comprising an upholstered box frame” and “a backrest comprising an upholstered box frame, the backrest being displaceably arranged relative to the seat base.” Furthermore, the present application claims that the backrest of the instant invention is displaceably arranged “between a first, retracted position in which the backrest is substantially in register with the seat back and a second, extended position in which at least a part of the back rest protrudes upwardly beyond a top edge of the seat back.” Still further, the present application claims the use of “a fluid-operated displacement mechanism” and that “at least a part of the displacement mechanism [is] carried within the box frame of the backrest.”

The applicants respectfully submit that Shats, et al. does not teach or disclose any of the aforementioned features of the present invention as set forth in claim 1.

It is also the applicants’ opinion that it would not even have been obvious to one skilled in the art to have modified the device of Shats, et al. in order to make up for the

aforementioned deficiencies. The applicants submit that one skilled in the art would not have been motivated to modify the teachings of Shats, et al., nor would there even have been a reasonable expectation of success if one were to have modified it. Therefore, applicant respectfully submits that an obviousness-type rejection under Section 103 would not be applicable in this instance and that the current anticipation rejection under Section 102(e) should be withdrawn.

Rejection of Claims 1-3 under 35 U.S.C. 103(a)

Claims 1 – 3 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,603,275 (Kuebler). The Examiner states that Kuebler shows a structure similar to the presently claimed invention, including a seat base, back frame and a displaceable backrest and further states that to have formed the back and backrest as upholstered box frames, for aesthetic purposes, would have been obvious to one skilled in the art as such are old and well known in the art.

The applicants respectfully submit that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references when combined must teach or suggest all of the claim limitations (see also *In re Royka*, 490 F.2d 981 (C.C.P.A.1974)). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure (M.P.E.P. Sec. 706.02(j)).

The applicants submit that Kuebler does not teach or suggest every feature of the

presently claimed invention, namely, Kuebler fails to teach or describe the use of a concealed fluid operated mechanism and does not show the use of the box frames for the seat back and backrest. Moreover, the applicants submit that one skilled in the art would not rely on the teachings of Kuebler in order to arrive at the present invention as set forth in claims 1-3 since the fluid operated mechanism of the present invention, as set forth in claim 1, would not work with the ratchet-type adjustment device of Kuebler. Therefore, one skilled in the art would not have any motivation whatsoever to modify the device of Kuebler to arrive at the present invention.

The applicants further submit that it is not sufficient to merely allege that to have formed the seat back and backrest as upholstered box frames would have been obvious to one of ordinary skill in the art as old and well known in the art. The applicant respectfully submits that official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances, such as when the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known (M.P.E.P. 2144.03), which is not the case in this instance. It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known (*Id.*). Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge (*In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary

skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). The Examiner has not made any reference to concrete evidence to support this conclusion and it is not instantly and unquestionably demonstrated as being well known. For this reason the applicants respectfully believe that the Examiner's conclusion to arrive at the current obviousness rejection is groundless.

Because there would be no motivation to rely on Kuebler to arrive at the present invention and because every limitation of the present invention is not taught by the reference even if one skilled in the art were to rely on it, the prior art reference must be withdrawn as the basis for the present obviousness rejection since the presently claimed invention is clearly patentably distinguishable over the device of Kuebler. Therefore, the applicants respectfully request that this rejection be withdrawn.

Rejection of Claims 1, 8 and 9 under 35 U.S.C. 103(a)

Claims 1, 8 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,095,606 (Opsvik). The Examiner states that figures 1 and 6 of Opsvik show a backrest that is displaceable relative to a seat back by means of a pneumatic displacement system.

As noted above, to establish a *prima facie* case of obviousness, the prior art references when combined must teach or suggest all of the claim limitations. In this instance, Opsvik does not disclose every feature set forth in claims 1, 8 and 9. Particularly, Opsvik does not teach or disclose the feature that the seat back and backrest are upholstered box frames as recited in claim 1 of the instant application. Moreover,

Opsvik fails to teach or disclose the seat back of the present claim 1, nor does Opsvik disclose a fluid operated displacement mechanism for displacing the seat back relative to the backrest. Clearly, every feature of the present invention is not set forth in the reference.

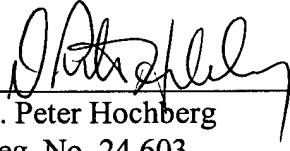
The applicants also respectfully disagree with the Examiner's conclusion that Opsvik discloses a pneumatic displacement system 30. The applicants respectfully submit that Opsvik shows a schematic drawing with a pneumatic cylinder 30 at Figure 6. There is no description therein of how the pneumatic cylinder operates apart from a brief sentence stating that "it should be clear that it will also be possible to employ a hydraulic or pneumatic aids as shown in Figure 6, at reference numeral 30 ..." (col. 4, lines 16-19). Moreover, the applicants respectfully submit that it is well established that a cited reference must be sufficiently enabling (*In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985), stating that if a prior art reference cited in an obviousness rejection does not enable a relevant part of the claimed invention, the reference does not disclose that part of the claimed invention for prior art purposes.) In this case, it is respectfully submitted that Opsvik does not disclose the claimed invention in that each and every limitation is not set forth therein and so that one of ordinary skill in the art could combine the prior art's disclosure with his or her own knowledge to arrive at the presently claimed invention. Therefore, it is respectfully submitted that this rejection be withdrawn.

Conclusion

For the foregoing reasons, it is believed that the present application as amended is in condition for allowance, and such action is earnestly solicited. The Examiner is invited

to call the undersigned if there are any remaining issues to be discussed which could expedite the prosecution of the present application.

Respectfully submitted,

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